

REMARKS

Applicants have reviewed this Application in light of the Office Action mailed March 7, 2006. Claims 2 and 21 have been cancelled without prejudice or disclaimer and Claims 1, 3-20, and 22-28 are pending in this Application. Claims 1, 7-15, 18, 20 and 28 stand rejected under 35 U.S.C. § 102(e) and Claims 3-6 and 22-27 stand rejected under 35 U.S.C. § 103(a). Claims 1, 3, 5, 6, 20, and 22-24 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102(e)

Claims 1, 7-15, 18, 20 and 28 were rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Suttle.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that Suttle does not anticipate Claim 1 as amended, because Suttle does not show all elements of claim 1.

In response to the anticipation rejection of Claim 1, Applicants have amended the claim to incorporate the limitations of original Claim 2 (now canceled). Original Claim 2 was rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable under Suttle in view of Morscheck.

Applicants respectfully traverse the Section 103(a) rejection of Original Claim 2 and amended Claim 1. Applicants respectfully submit that the combination of Suttle and Morscheck does not anticipate Claim 24, because Suttle and Morscheck, either alone or in combination, do not show all the elements of the present Claims.

The references, for example, fail to disclose or suggest, a method of manufacturing a photomask component comprising “automatically selecting a template including customer specifications based on at least one criteria indicated in [a] product order information file” and “validating the product order information by automatically comparing the product order information to the template to identify any inconsistencies” as specifically recited in Claim 24. The Office Action concedes that Suttile does not teach these claimed elements, and asserts that the claimed elements are taught by Morscheck at Column 16, line 1 and Column 3, lines 3-11. (Office Action, Page 7). The cited portions of Morscheck read as follows:

Clicking an Order Type drop-down list arrow allows a user to select the Order Type: (Quote, Template, or WIP) for logical grouping of a users [sic] work.

(Col. 15, line 67 - Col. 16, line 2).

[A] forms order entry system is provided comprising a user interface, a validation engine, and a pricing engine. The validation engine is in communication with the user interface and is programmed to (i) generate manufacturing steps based on form design data generated at the user interface, wherein the form design data defines the appearance and construction of an ordered form, and wherein the manufacturing steps correspond to a specific manufacturing process for creating the ordered form, (ii) determine manufacturability/usability of the ordered form by comparing the form design data to a set of validation rules, and (ii) generate manufacturability/usability exceptions based upon the manufacturability determination.

(Col. 2, line 67 - Col. 3, line 12).

The cited portions of Morscheck do not disclose or suggest “automatically selecting a template including customer specifications based on at least one criteria indicated in [a] product order information file” and “validating the product order information by automatically comparing the product order information to the template to identify any inconsistencies” as recited in amended Claim 1.

First, the “template” contemplated in Morscheck cannot be equated to the template recited in Claim 1. Morscheck uses the term “template” merely to refer to a particular type of

form order. As stated in Morscheck “[a] quote, a WIP, and a template each describe a form order but are identified with different terms merely to provide a means of distinguishing their respective status’s [sic].” For example, a quote is a priced order, a WIP is an order in the process of being priced, and a template is an archived order utilized to create new orders.” (Col. 9, lines 22-28). Thus, unlike the template recited in Claim 1, which is compared to product order information for order validation purposes and contains information from which the production data file is generated, the “template” contemplated in Morscheck is merely a skeleton form used to create new forms, but is not automatically compared to new orders for validation purposes.

In addition, Claim 1 recites that a template is “automatically selected.” However, the portion of Morscheck cited by the Examiner states: “Clicking an Order Type drop-down list arrow allows a user to select the Order Type: (Quote, Template, or WIP) for logical grouping of a users work.” (Col. 15, line 67 - Col. 16, line 2). Thus, even assuming the “template” contemplated by Morscheck can be equated to the template recited in Claim 1, which Applicants do not concede, Morscheck clearly contemplates such a template is selected manually, not automatically. Thus, Suttle and Morscheck, either alone or in combination, fails to teach, disclose or suggest the template selection and verification recited in amended Claim 1. Suttle and Morscheck fail to disclose the recited limitations, and therefore, cannot render obvious Claim 1.

In response to the anticipation rejection of independent Claim 20, Applicants have amended to include the limitations of original Claim 21 such that Claim 20 recites template selection and verification similar to that of amended Claim 1, discussed above. Original Claim 21 was rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable under Suttle in view of Morscheck for the reasons analogous discussed above with respect to Claim 1. Applicants submit that, for reasons analogous to those set forth above with respect to amended Claim 1, amended Claim 20, and its dependent claims, are novel and nonobvious over Suttle and Morscheck.

Rejections under 35 U.S.C. § 103(a) based on Suttle

Because a claim that depends on a nonobvious claim is inherently nonobvious (MPEP 2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)), the Section 103(a) rejection of claims 16-19 is overcome by the amendments to and remarks regarding claim 1 discussed above.

Rejections under 35 U.S.C. § 103(a) based on Suttle and Morscheck

Because a claim that depends on a nonobvious claim is inherently nonobvious, the Section 103(a) rejection of claims 16-19 is overcome by the amendments to and remarks regarding claim 1 discussed above.

With respect to independent Claim 24 and its dependent claims, Applicants respectfully traverse the obviousness rejection for reasons analogous to the reasons presented above with respect to amended claims 1 and 20.

Information Disclosure Statement

Applicants would like to bring to the Examiner's attention that the Examiner made no indication that Reference "T" submitted with Information Disclosure Statement and PTO Form 1449 filed on June 27, 2003 had been considered in the Office Action mailed March 7, 2006. Applicants respectfully request confirmation of the consideration of Reference "T". Applicants attach a copy of the PTO Form 1449 that was attached to the Office Action mailed March 7, 2006, and respectfully request that the Examiner place his initials next to Reference "T" if citation is to be considered or draw a line through the citation if the citation is not to be considered.

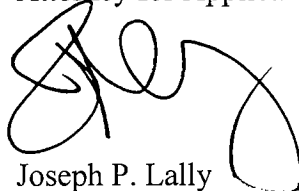
CONCLUSION

Applicants appreciate the Examiner's careful review of the Application. Applicants believe that this case is in condition for allowance. Applicants respectfully request reconsideration of the application and allowance of Claims 1, 3-19, 20, and 22-28.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2680.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Joseph P. Lally
Registration No. 38,947

Date: June 7, 2006

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2680

512.322.8359 (fax)